

REMARKS

Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

The Examiner's communication of January 22, 2007, together with the references cited therein, have been given careful consideration. After such consideration, and in an earnest effort to complete the prosecution of this application, the Applicants have set down the following arguments in support of the patentability of claims 1-20.

To assist the Examiner in reconsidering this application, the following is a presentation based on the language employed in claims 1, 11, and 15 when read on the embodiment presented in Figs. 1-3. Claim 1 recites a system for enabling a mobile data acquisition device. The system comprises a software application for use with the mobile data acquisition device. The software application is located on a remote computer. The remote computer transfers the software application from the remote computer to the mobile data acquisition

device. The remote computer installs and activates the software application for use by the mobile data acquisition device. The software application is determined by a user and replaces a factory default software application.

Claim 11 recites a system for enabling a software application. The system comprises a data acquisition device for use with the software application and a remote computer for transmitting the software application from the remote computer to the data acquisition device. The remote computer installs and activates the software application for use by the data acquisition device. The data acquisition device has the capability of disabling a software application of the data acquisition device.

Claim 15 recites a computer program product for enabling a software application. The computer program product comprises: a first instruction for initiating communication between a mobile device and a remote computer; a second instruction for requesting the state of the mobile device by

the remote computer; a third instruction for responding to the remote computer by the mobile device with a factory default state message; a fourth instruction for initiating transfer of a software application from the remote computer to the mobile device; and a fifth instruction for acknowledging receipt of the software application from the remote computer by the mobile device thereby enabling the software application at the mobile device.

Claims 1-3, 6-7, 9, 11-12, and 15-20 have been objected to. The Office Action states that the limitations following the word "for" do not carry patentable weight (Office Action, page 2, paragraph 2). Applicant's representative is unaware of any law or rule enacted by the courts or the MPEP that support this statement. If this objection is maintained, Applicant's representative respectfully requests that the source and basis of this statement be cited in the next Office Action.

The following is our understanding of the law regarding this issue. Functional language does not, in and of itself,

render a claim improper. MPEP §2173.05(g). A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. MPEP §2173.05(g).

Further, all words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 165 USPQ 494, 496 (CCPA 1970). The elements of a prior art reference must be arranged in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 9 USPQ.2d 1913, 1920 (Fed. Cir. 1990). The proper inquiry is whether a claim is patentably distinguishable over the disclosure of the prior art. See In re Garnero, 162 USPQ 221, 223 (CCPA 1969); Water Tech. Corp. v. Calco Ltd., 7 USPQ.2d 1097, 1102 (Fed. Cir. 1988).

Claims 15-20 have been rejected as being directed to non-statutory subject matter under 35 USC §101. Claims 15-20 have been amended to overcome this rejection.

Claims 1-8, 11, 13-20 have been rejected as anticipated by Delo et al., US 6,370,686. Claims 9, 10, and 12 have been rejected as unpatentable over Delo et al. '686 in view of Delo et al., US 6,804,663.

Amended claims 1, 11, and 15 now each recite transferring a software application to a hand-held, mobile device (Specification, page 16, lines 23-24). Delo et al. '686 and the other art of record do not disclose transferring a software application to a hand-held, mobile device. The art of record does not even disclose transferring a software application to a mobile device.

Additionally, claim 9 recites that the remote computer maintains an application installation log for determining software applications enabled at a given time. Claims 10 recites that the remote computer requests an application activation file from the mobile data acquisition device. Claim 12 recites that the remote computer initiates transfer of the software application subsequent to the mobile data

acquisition device sending an application activation file to the remote computer.

The Office Action states the following:

It would have obvious to one of ordinary skill in the art at the time the invention was made to modify Delo (US 6,370,686 B1)'s approach to gather information regarding the current state of the target computer. (See Office Action, page 14 regarding claim 9).

It would have obvious to one of ordinary skill in the art at the time the invention was made to modify Delo (US 6,370,686 B1)'s approach to gather information of the installation process. (See Office Action, page 15 regarding claim 10).

It would have obvious to one of ordinary skill in the art at the time the invention was made to modify Delo (US 6,370,686 B1)'s approach to have installation information gathered. (See Office Action, page 16 regarding claim 12).

Thus, it appears that the position of the Office Action is that it would have been obvious to reprogram the target computer (20) of Delo et al. '686 to perform these functions recited in claims 9, 10, and 12.

The M.P.E.P. sets forth the following criteria for an obviousness rejection under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, MPEP §706.02(j).

The structure of a system or product for carrying out an algorithm is limited by the disclosed algorithm. See WMS Gaming Inc. v. Int'l Game Tech., 184 F.3d 1339, 1348 (Fed. Cir. 1999). A new machine (a special purpose computer) is created when a general purpose computer is programmed to carry out an algorithm for performing one or more particular functions. Id. citing In Re Alappat, 33 F.3d 1526, 1545 (Fed. Cir. 1994) (*en banc*). When a general purpose computer is programmed to perform a particular function by using a discovery not specified in the prior art, the resulting system or product would not be obvious under 35 U.S.C. §103 "because one not having knowledge of the [inventor's] discovery simply

would not know what to program the computer to do." See In re Prater, 415 F.2d 1393, 1397-98 (CCPA 1969).

For an obviousness rejection under 35 U.S.C. §103, the prior art must be analyzed at the time the invention was made. The use of the teachings of the present invention to find obviousness is impermissible.

Obviousness must not be read into an invention on the basis of applicant's own statements; that is, the prior art must be viewed without reading into that art the applicant's teachings. The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention obvious. In Re Sponnoble, 160 USPQ 237, 243 (CCPA 1969) (emphasis in original).

Accordingly, the Examiner must consider only the teachings of the prior art references.

As admitted in the Office Action, Delo et al. '686 fails to teach or suggest the limitations of claims 9, 10, and 12. (Office Action, pages 13-15). Therefore, it is clear that the

features of claims 9, 10, and 12 are not taught by Delo et al. '686. According to WMS Gaming Inc., 184 F.3d at 1348, the system or product of claims 9, 10, and 12 define the algorithm for maintaining an application installation log for determining software applications enabled at a given time (claim 9), requesting an application activation file from the mobile data acquisition device (claim 10), and initiating transfer of the software application subsequent to the mobile data acquisition device sending an application activation file to the remote computer (claim 12). Since Delo et al. '686 admittedly fails to teach or suggest these limitations, Delo et al. '686 fails to teach or suggest a system or product as recited in claims 9, 10, or 12. Since Delo et al. '686 fails to teach or suggest each feature of the claimed invention, it is respectfully submitted that it would not have been obvious to one of ordinary skill in the art to combine Delo et al. '686 and Delo et al. '663.

Additionally, when an algorithm is not taught or suggested by a prior art reference, one of ordinary skill in

the art would not know what to program a computer to do. See e.g., In re Prater, 415 F.2d at 1397-98. Thus, a new system or product has been created when a computer is programmed to carry out an algorithm to perform a particular function, as in claims 9, 10, and 12. WMS Gaming Inc., 184 F.3d at 1348. Therefore, it is respectfully submitted that it would not have been obvious for one of ordinary skill in the art to reprogram the target computer of Delo et al. '686, in view of Delo et al. '663, to produce the limitations of claims 9, 10, and 12.

Furthermore, in rejecting claims 9, 10, and 12 as obvious over Delo et al. '686 in view of Delo et al. '663, it is respectfully suggested that improper hindsight has been used. Delo et al. '686 fails to teach or suggest maintaining an application installation log for determining software applications enabled at a given time (claim 9), requesting an application activation file from the mobile data acquisition device (claim 10), and initiating transfer of the software application subsequent to the mobile data acquisition device sending an application activation file to the remote computer

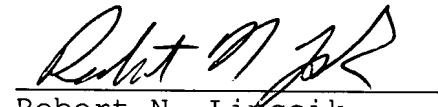
(claim 12). Thus, without reference to the teachings of the disclosure of the present invention, one of ordinary skill in the art would not have the requisite knowledge to modify Delo et al. '686 with Delo et al. '663.

According to In Re Sponnoble, 160 USPQ at 243 (CCPA 1969), such hindsight is impermissible. Therefore, it is respectfully submitted that for this further reason, the rejection of claims 9, 10, and 12 are improper.

Consequently, claims 1, 11, and 15, as well as claims 2-10, 12-14, and 16-20 which depend from claims 1, 11, and 15, respectively, are in condition for allowance. Allowance of the subject application is respectfully requested.

Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,



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